



# UNITED STATES PATENT AND TRADEMARK OFFICE

UNITED STATES DEPARTMENT OF COMMERCE  
United States Patent and Trademark Office  
Address: COMMISSIONER OF PATENTS AND TRADEMARKS  
Washington, D.C. 20231  
www.uspto.gov

APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
-----------------	-------------	----------------------	---------------------	------------------

09/932,888

08/20/2001

Michael E. Spurlock

PM-8935-A

7993

22202

7590

03/07/2003

WHYTE HIRSCHBOECK DUDEK S C  
111 EAST WISCONSIN AVENUE  
SUITE 2100  
MILWAUKEE, WI 53202

EXAMINER

SAOUD, CHRISTINE J

ART UNIT

PAPER NUMBER

1647

DATE MAILED: 03/07/2003

Please find below and/or attached an Office communication concerning this application or proceeding.

# Office Action Summary

Application No.  
09/932,888

Applicant(s)  
SPURLOCK

Examiner  
Christine Saoud

Art Unit  
1647



-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

## Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 1 MONTH(S) FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136 (a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If the period for reply specified above is less than thirty (30) days, a reply within the statutory minimum of thirty (30) days will be considered timely.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133).
- Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

## Status

- 1) ☐ Responsive to communication(s) filed on \_\_\_\_\_.
- 2a) ☐ This action is **FINAL**. 2b) ☒ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11; 453 O.G. 213.

## Disposition of Claims

- 4) ☒ Claim(s) 1-12 is/are pending in the application.
- 4a) Of the above, claim(s) \_\_\_\_\_ is/are withdrawn from consideration.
- 5) ☐ Claim(s) \_\_\_\_\_ is/are allowed.
- 6) ☐ Claim(s) \_\_\_\_\_ is/are rejected.
- 7) ☐ Claim(s) \_\_\_\_\_ is/are objected to.
- 8) ☒ Claims 1-12 are subject to restriction and/or election requirement.

## Application Papers

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☐ The drawing(s) filed on \_\_\_\_\_ is/are a) ☐ accepted or b) ☐ objected to by the Examiner.  
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).
- 11) ☐ The proposed drawing correction filed on \_\_\_\_\_ is: a) ☐ approved b) ☐ disapproved by the Examiner.  
If approved, corrected drawings are required in reply to this Office action.
- 12) ☐ The oath or declaration is objected to by the Examiner.

## Priority under 35 U.S.C. §§ 119 and 120

- 13) ☐ Acknowledgement is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).  
a) ☐ All b) ☐ Some\* c) ☐ None of:  
1. ☐ Certified copies of the priority documents have been received.  
2. ☐ Certified copies of the priority documents have been received in Application No. \_\_\_\_\_.  
3. ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).  
\*See the attached detailed Office action for a list of the certified copies not received.
- 14) ☐ Acknowledgement is made of a claim for domestic priority under 35 U.S.C. § 119(e).  
a) ☐ The translation of the foreign language provisional application has been received.
- 15) ☐ Acknowledgement is made of a claim for domestic priority under 35 U.S.C. §§ 120 and/or 121.

## Attachment(s)

- 1) ☐ Notice of References Cited (PTO-892) 4) ☐ Interview Summary (PTO-413) Paper No(s). \_\_\_\_\_
- 2) ☐ Notice of Draftsperson's Patent Drawing Review (PTO-948) 5) ☐ Notice of Informal Patent Application (PTO-152)
- 3) ☐ Information Disclosure Statement(s) (PTO-1449) Paper No(s). \_\_\_\_\_ 6) ☐ Other:

## **DETAILED ACTION**

### ***Election/Restriction***

1. Restriction to one of the following inventions is required under 35 U.S.C. 121:
  - I. Claims 1-5, drawn to DNA encoding porcine leptin, vectors, and host cells, classified in at least class 435, subclass 69.1, for example.
  - II. Claims 6-9, drawn to antisense RNA, classified in class 514, subclass 44.
  - III. Claims 10-11, drawn to porcine leptin, classified in class 530, subclass 350, for example.
  - IV. Claim 12, drawn to an antibody, classified in class 530, subclass 387.1, for example.
2. The inventions are distinct, each from the other because of the following reasons:
3. Group I is independent and distinct from Group III because the DNAs, vectors, and host cells are materially different from and are therefore independent and distinct from the polypeptides of Group III. Additionally, the DNAs, vectors, and host cells of Group I are not needed to produce the polypeptides of Group III because the polypeptides of Group III may be purified from naturally occurring sources or may be synthesized chemically. Neither is any of the polypeptides claimed in Group III needed to practice the polypeptide production method of Group I. The DNAs, vectors, host cells, and methods of Group I are materially different from and are therefore independent and distinct from the antibodies of Group IV, not necessary for the production of any of the antibodies of Group IV, nor are the antibodies of Group IV necessary to practice any of the methods of Group I. The DNAs, vectors, host cells and methods of Group I

are independent and distinct from the antisense molecules of Group III because the inventions are materially different and because the antisense molecules have different effects and functions from the DNAs of Group I and well as not necessary for the practice of the methods of Group I.

4. Group III is independent and distinct from Groups III-IV because the polypeptides are materially different from and are therefore independent and distinct from the antibodies of Group IV and the antisense molecules of Group IV. Although the polypeptides of Group III are necessary to generate the antibodies of Group IV, the polypeptides could be used in an entirely different manner, such as in a therapeutic method. The polypeptides of Group III and the antibodies of Group IV and the antisense molecules of Group III have different modes of operation, different functions, and different effects, and are therefore, independent and distinct.

5. Group IV is independent and distinct from Group III because the antibodies are materially different from and are therefore independent and distinct from the antisense molecules of Group III. The antibodies of Group IV and the antisense molecules of Group III have different modes of operation, different functions, and different effects, and are therefore, independent and distinct.

6. The inventions of each named pair can be shown to be distinct because they do not rely upon each other for their ultimate use and they require non-coextensive literature searches. The compounds are structurally different and the methods have different goals, method steps, and/or starting materials. Because these inventions are distinct for the reasons given above and have acquired a separate status in the art as shown by their different classification and the necessity for non-coextensive literature searches, restriction for examination purposes as indicated is proper.

Any inquiry concerning this communication or earlier communications from the Examiner should be directed to Christine J. Saoud, Ph.D., whose telephone number is (703) 305-7519. The Examiner can normally be reached on Monday to Thursday from 8AM to 2PM. If attempts to reach the Examiner by telephone are unsuccessful, the Examiner's supervisor, Gary Kunz, can be reached on (703) 308-4623.

Certain papers related to this application may be submitted to Technology Center 1600 by facsimile transmission. Papers should be faxed to Technology Center 1600 via the PTO Fax Center located in Crystal Mall 1 (CM1). The faxing of such papers must conform with the notices published in the Official Gazette, 1156 OG 61 (November 16, 1993) and 1157 OG 94 (December 28, 1993) (see 37 C.F.R. §§ 1.6(d) and 1.8). NOTE: If Applicant *does* submit a paper by fax, the original signed copy should be retained by Applicant or Applicant's representative. NO DUPLICATE COPIES SHOULD BE SUBMITTED so as to avoid the processing of duplicate papers.

Official papers filed by fax should be directed to (703) 872-9306. If this number is out of service, please call the Group receptionist for an alternate number. Official papers filed After Final rejection filed by fax should be directed to (703) 872-9307.

Any inquiry of a general nature or relating to the status of this application or proceeding should be directed to the Group receptionist whose telephone number is (703) 308-0196.

**CHRISTINE J. SAOUD**  
**PRIMARY EXAMINER**

*Christine J. Saoud*